

(b) Any invention made, used or sold in outer space on a space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space, shall be considered to be made, used or sold within the United States for the purposes of this title if specifically so agreed in an international agreement between the United States and the state of registry.

(Added Pub. L. 101-580, §1(a), Nov. 15, 1990, 104 Stat. 2863.)

#### EFFECTIVE DATE; SPECIAL RULES

Section 2 of Pub. L. 101-580 provided that:

“(a) EFFECTIVE DATE.—Subject to subsections (b), (c), and (d) of this section, the amendments made by the first section of this Act [enacting this section] shall apply to all United States patents granted before, on, or after the date of enactment of this Act [Nov. 15, 1990], and to all applications for United States patents pending on or filed on or after such date of enactment.

“(b) FINAL DECISIONS.—The amendments made by the first section of this Act [enacting this section] shall not affect any final decision made by a court or the Patent and Trademark Office before the date of enactment of this Act [Nov. 15, 1990] with respect to a patent or an application for a patent, if no appeal from such decision is pending and the time for filing an appeal has expired.

“(c) PENDING CASES.—The amendments made by the first section of this Act [enacting this section] shall not affect the right of any party in any case pending in a court on the date of enactment of this Act [Nov. 15, 1990] to have the party’s rights determined on the basis of the substantive law in effect before such date of enactment.

“(d) NON-APPLICABILITY.—The amendments made by the first section of this Act [enacting this section] shall not apply to any process, machine, article of manufacture, or composition of matter, an embodiment of which was launched prior to the date of enactment of this Act [Nov. 15, 1990].”

### CHAPTER 11—APPLICATION FOR PATENT

Sec.	
111.	Application.
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#### AMENDMENTS

1999—Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4507(5)], Nov. 29, 1999, 113 Stat. 1536, 1501A-566, inserted “; publication of patent applications” after “applications” in item 122.

1994—Pub. L. 103-465, title V, §532(c)(6), Dec. 8, 1994, 108 Stat. 4987, substituted “Application” for “Application for patent” in item 111 and “Benefit of earlier filing date; right of priority” for “Benefit of earlier filing date in foreign country; right of priority” in item 119.

#### CHAPTER REFERRED TO IN OTHER SECTIONS

This chapter is referred to in sections 371, 373, 375 of this title.

<sup>1</sup>Section catchline amended by Pub. L. 97-247 without corresponding amendment of chapter analysis.

### § 111. Application

(a) IN GENERAL.—

(1) WRITTEN APPLICATION.—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title; and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) CLAIM.—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) FEE.—(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) FILING DATE.—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) ABANDONMENT.—Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section

119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) OTHER BASIS FOR PROVISIONAL APPLICATION.—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.—A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) APPLICABLE PROVISIONS.—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

(July 19, 1952, ch. 950, 66 Stat. 798; Pub. L. 97-247, § 5, Aug. 27, 1982, 96 Stat. 319; Pub. L. 103-465, title V, § 532(b)(3), Dec. 8, 1994, 108 Stat. 4986; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4732(a)(10)(A), 4801(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582, 1501A-588.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 33 (R.S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958; (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The corresponding section of existing statute is divided into an introductory section relating to the application generally (this section) and a section on the specification (sec. 112).

The parts of the application are specified and the requirement for signature is placed in this general section so as to insure that only one signature will suffice.

#### AMENDMENTS

1999—Subsecs. (a)(1), (3), (4), (b)(1), (3)(B), (C). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(a)(10)(A)], substituted “Director” for “Commissioner”.

Subsec. (b)(5). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4801(a)], amended heading and text of par. (5) generally. Prior to amendment, text read as follows: “The provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival thereafter.”

Subsec. (b)(6). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(a)(10)(A)], substituted “Director” for “Commissioner”.

1994—Pub. L. 103-465 amended section generally. Prior to amendment, section read as follows: “Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submit-

ting the fee and oath was unavoidable. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.”

1982—Pub. L. 97-247 inserted “, or authorized to be made,” after “shall be made”, struck out the colon after “shall include”, struck out “signed by the applicant and” after “The application”, and inserted provisions that the fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner, that upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable, and that the filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, § 4732(a)(10)(A)] of Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

Amendment by section 1000(a)(9) [title IV, § 4801(a)] of Pub. L. 106-113 effective Nov. 29, 1999, and applicable to any provisional application filed on or after June 8, 1995, see section 1000(a)(9) [title IV, § 4801(d)] of Pub. L. 106-113, set out as a note under section 119 of this title.

#### EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103-465 effective 6 months after Dec. 8, 1994, and applicable to all patent applications filed in the United States on or after that effective date, with provisions relating to earliest filed patent application, see section 534(b)(1), (3) of Pub. L. 103-465, set out as a note under section 154 of this title.

#### EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as an Effective Date note under section 294 of this title.

#### EMERGENCY RELIEF FROM POSTAL SITUATION AFFECTING PATENT, TRADEMARK, AND OTHER FEDERAL CASES

Pub. L. 92-34, June 30, 1971, 85 Stat. 87, provided that a patent or trademark application would be considered filed in the United States Patent Office on the date that it would have been received by the Patent Office except for the delay caused by emergency situation affecting postal service from Mar. 18, 1970 to Mar. 30, 1970, if a claim was made.

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 122, 154 of this title.

### § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

(July 19, 1952, ch. 950, 66 Stat. 798; Pub. L. 89-83, §9, July 24, 1965, 79 Stat. 261; Pub. L. 94-131, §7, Nov. 14, 1975, 89 Stat. 691.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §33 (R.S. 4888, amended (1) Mar. 3, 1915, ch. 94, §1, 38 Stat. 958; (2) May 23, 1930, ch. 312, §2, 46 Stat. 376).

The sentence relating to signature of the specification is omitted in view of the general requirement for a signature in section 111.

The last sentence is omitted for inclusion in the chapter relating to plant patents.

The clause relating to machines is omitted as unnecessary and the requirement for disclosing the best mode of carrying out the invention is stated as generally applicable to all types of invention (derived from Title 35, U.S.C., 1946 ed., §69, first defense).

The clause relating to the claim is made a separate paragraph to emphasize the distinction between the description and the claim or definition, and the language is modified.

A new paragraph relating to functional claims is added.

#### AMENDMENTS

1975—Pub. L. 94-131 substituted provision authorizing the writing of claims, if the nature of the case admits, in dependent or multiple dependent form for prior provision for writing claims in dependent form, required claims in dependent form to contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed, substituted text respecting construction of a claim in dependent form so as to incorporate by reference all the limitations of the claim to which it refers for prior text for construction of a dependent claim to include all the limitations of the claim incorporated by reference into the dependent claim, and inserted paragraph respecting certain requirements for claims in multiple dependent form.

1965—Pub. L. 89-83 permitted a claim to be written in independent or dependent form, and if in dependent form, required it to be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

#### EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94-131 effective Jan. 24, 1978, and applicable on and after that date to patent applica-

tions filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94-131, set out as an Effective Date note under section 351 of this title.

#### EFFECTIVE DATE OF 1965 AMENDMENT

Amendment by Pub. L. 89-83 effective three months after July 24, 1965, see section 7(a) of Pub. L. 89-83, set out as a note under section 41 of this title.

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 41, 111, 119, 120, 157, 162, 282 of this title.

### § 113. Drawings

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

(July 19, 1952, ch. 950, 66 Stat. 799; Pub. L. 94-131, §8, Nov. 14, 1975, 89 Stat. 691; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §34, part (R.S. 4889, amended Mar. 3, 1915, ch. 94, §2, 38 Stat. 958).

The requirement for signature in the corresponding section of existing statute is omitted; regulations of the Patent Office can take care of any substitute. A redundant clause is omitted.

#### AMENDMENTS

1999—Pub. L. 106-113 substituted “Director” for “Commissioner”.

1975—Pub. L. 94-131 substituted provisions respecting drawings requiring necessary-for-understanding drawings and submission of drawings within prescribed time period and limiting use of drawings submitted after filing date of application for prior provision requiring the applicant to furnish a drawing when the nature of the case admitted it.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

#### EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94-131 effective Jan. 24, 1978, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94-131, set out as an Effective Date note under section 351 of this title.

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 111 of this title.

### § 114. Models, specimens

The Director may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Director may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

(July 19, 1952, ch. 950, 66 Stat. 799; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §34, part (R.S. 4890 and 4891).

The change in language in the second paragraph broadens the requirement for specimens.

#### AMENDMENTS

1999—Pub. L. 106-113 substituted “Director” for “Commissioner” in two places.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

### § 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when, made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority is proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. For purposes of this section, a consular officer shall include any United States citizen serving overseas, authorized to perform notarial functions pursuant to section 1750 of the Revised Statutes, as amended (22 U.S.C. 4221).

(July 19, 1952, ch. 950, 66 Stat. 799; Pub. L. 97-247, §14(a), Aug. 27, 1982, 96 Stat. 321; Pub. L. 105-277, div. G, title XXII, §2222(d), Oct. 21, 1998, 112 Stat. 2681-818.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §35 (R.S. 4892, amended (1) Mar. 3, 1903, ch. 1019, §2, 32 Stat. 1225, 1226, (2) May 23, 1930, ch. 312, §3, 46 Stat. 376).

The expression at the end of the second sentence is added to avoid application of the District of Columbia law to oaths taken outside the District.

Changes in language are made.

#### AMENDMENTS

1998—Pub. L. 105-277 inserted at end “For purposes of this section, a consular officer shall include any United

States citizen serving overseas, authorized to perform notarial functions pursuant to section 1750 of the Revised Statutes, as amended (22 U.S.C. 4221).”

1982—Pub. L. 97-247 substituted “is” for “shall be” after “whose authority”, and inserted “, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States”.

#### EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective Aug. 27, 1982, see section 17(a) of Pub. L. 97-247, set out as a note under section 41 of this title.

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 111, 371 of this title.

### § 116. Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

(July 19, 1952, ch. 950, 66 Stat. 799; Pub. L. 97-247, §6(a), Aug. 27, 1982, 96 Stat. 320; Pub. L. 98-622, title I, §104(a), Nov. 8, 1984, 98 Stat. 3384; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582.)

#### HISTORICAL AND REVISION NOTES

The first paragraph is implied in the present statutes, and the part of the last paragraph relating to omission of an erroneously joined inventor is in the Patent Office rules. The remainder is new and provides for the correction of a mistake in erroneously joining a person as inventor, and for filing an application when one of several joint inventors cannot be found. This section is ancillary to section 256.

#### AMENDMENTS

1999—Pub. L. 106-113 substituted “Director” for “Commissioner” in two places.

1984—Pub. L. 98-622 amended first par. generally, striking out “and each sign the application” after “patent jointly” and inserting sentence beginning “Inventors may apply”.

1982—Pub. L. 97-247 substituted “Inventors” for “Joint inventors” as section catchline, and substituted

“through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application” for “a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error”.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

#### EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-622 applicable to all United States patents granted before, on, or after Nov. 8, 1984, and to all applications for United States patents pending on or filed after that date, except as otherwise provided, see section 106 of Pub. L. 98-622, set out as a note under section 103 of this title.

#### EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as an Effective Date note under section 294 of this title.

### § 117. Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

(July 19, 1952, ch. 950, 66 Stat. 799.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 46 (R.S. 4896, amended (1) Feb. 28, 1899, ch. 227, 30 Stat. 915, (2) Mar. 3, 1903, ch. 1019, § 3, 32 Stat. 1225, 1226, (3) May 23, 1908, ch. 188, 35 Stat. 245).

The language has been considerably simplified.

### § 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

(July 19, 1952, ch. 950, 66 Stat. 799; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582.)

#### HISTORICAL AND REVISION NOTES

This section is new and provides for the filing of an application by another on behalf of the inventor in certain special hardship situations.

#### AMENDMENTS

1999—Pub. L. 106-113 substituted “Director” for “Commissioner” in two places.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731]

of Pub. L. 106-113, set out as a note under section 1 of this title.

### § 119. Benefit of earlier filing date; right of priority

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner

and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.

(2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

(g) As used in this section—

(1) the term “WTO member country” has the same meaning as the term is defined in section 104(b)(2) of this title; and

(2) the term “UPOV Contracting Party” means a member of the International Convention for the Protection of New Varieties of Plants.

(July 19, 1952, ch. 950, 66 Stat. 800; Pub. L. 87-333, §1, Oct. 3, 1961, 75 Stat. 748; Pub. L. 92-358, §1, July 28, 1972, 86 Stat. 501; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 103-465, title V, §532(b)(1), Dec. 8, 1994, 108 Stat. 4985; Pub. L.

106-113, div. B, §1000(a)(9) [title IV, §§4503(a), (b)(2), 4801(b), (c), 4802], Nov. 29, 1999, 113 Stat. 1536, 1501A-563, 1501A-564, 1501A-588, 1501A-589.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §32, second paragraph (R.S. 4887, second paragraph, amended (1) Mar. 3, 1903, ch. 1019, §1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, §1, 53 Stat. 1212).

The first paragraph is the same as the present law with changes in language. The references to designs have been removed for inclusion in another section and the opening clause has been modified to accord with actual practice and the requirements of the International Convention for the Protection of Industrial Property.

The second paragraph is new, making an additional procedural requirement for obtaining the right of priority. Copies of the foreign papers on which the right of priority is based are required so that the record of the United States patent will be complete in this country.

#### REFERENCES IN TEXT

The Stockholm Revision of the Paris Convention, referred to in subsec. (d), means the Convention revising the Convention of the Union of Paris of Mar. 20, 1883, as revised, for the protection of industrial property, done at Stockholm July 14, 1967, entered into force for the United States Sept. 5, 1970, with the exception of Articles 1 through 12 which entered into force for the United States Aug. 25, 1973. See 21 UST 1583; 24 UST 2140; TIAS 6293, 7727.

#### AMENDMENTS

1999—Subsec. (a). Pub. L. 106-113, §1000(a)(9) [title IV, §4802(1)], which directed the insertion of “or in a WTO member country,” after “or citizens of the United States,” was executed by making insertion after “or to citizens of the United States,” to reflect the probable intent of Congress.

Subsec. (b). Pub. L. 106-113, §1000(a)(9) [title IV, §4503(a)], amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.”

Subsec. (e)(1). Pub. L. 106-113, §1000(a)(9) [title IV, §4503(b)(2)], inserted at end: “No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.”

Subsec. (e)(2). Pub. L. 106-113, §1000(a)(9) [title IV, §4801(c)], struck out before period at end “and the provisional application was pending on the filing date of the application for patent under section 111(a) or section 363 of this title”.

Subsec. (e)(3). Pub. L. 106-113, §1000(a)(9) [title IV, §4801(b)], added par. (3).

Subsecs. (f), (g). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4802(2)], added subsecs. (f) and (g).

1994—Pub. L. 103-465, in section catchline, struck out “in foreign country” after “date”, designated four undesignated paragraphs as subsecs. (a) to (d), and added subsec. (e).

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1972—Pub. L. 92-358 inserted last paragraph providing that under certain circumstances, applications for inventors’ certificate filed in a foreign country would be given the same priority as applications for patents, if the applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of filing.

1961—Pub. L. 87-333 authorized the right provided by this section to be based upon a subsequent application in the same foreign country, instead of the first application, provided that any foreign application filed prior to such subsequent one was withdrawn, or otherwise disposed of, without having been open to public inspection and without leaving any rights outstanding, nor any basis for claiming priority.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, § 4503(a), (b)(2)] of Pub. L. 106-113 effective on date that is 1 year after Nov. 29, 1999, and applicable to all applications filed under section 111 of this title on or after that date, and all applications complying with section 371 of this title that resulted from international applications filed on or after that date, see section 1000(a)(9) [title IV, § 4508] of Pub. L. 106-113, set out as a note under section 10 of this title.

Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4801(d)], Nov. 29, 1999, 113 Stat. 1536, 1501A-589, provided that: “The amendments made by this section [amending this section and section 111 of this title] shall take effect on the date of the enactment of this Act [Nov. 29, 1999] and shall apply to any provisional application filed on or after June 8, 1995, except that the amendments made by subsections (b) and (c) [amending this section] shall have no effect with respect to any patent which is the subject of litigation in an action commenced before such date of enactment.”

#### EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103-465 effective 6 months after Dec. 8, 1994, and applicable to all patent applications filed in the United States on or after that effective date, with provisions relating to earliest filed patent application, see section 534(b)(1), (3) of Pub. L. 103-465, set out as a note under section 154 of this title.

#### EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of Title 15, Commerce and Trade.

#### EFFECTIVE DATE OF 1972 AMENDMENT

Section 3(a) of Pub. L. 92-358 provided that: “Section 1 of this Act [amending this section] shall take effect on the date when Articles 1-12 of the Paris Convention of March 20, 1883, for the Protection of Industrial Property, as revised at Stockholm, July 14, 1967, come into force with respect to the United States [Aug. 25, 1973] and shall apply only to applications thereafter filed in the United States.”

#### EFFECTIVE DATE OF 1961 AMENDMENT

Amendment by Pub. L. 87-333 effective on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, Oct. 31, 1958, comes into force with respect to the United States [Jan. 4, 1962] and shall apply only to applications thereafter filed in the United States by persons entitled to the benefit of said convention, as revised at the time of such filing, see section 3 of Pub. L. 87-333, set out as a note under section 1126 of Title 15, Commerce and Trade.

#### JAPANESE AND CERTAIN GERMAN NATIONALS; TEMPORARY EXTENSION OF PRIORITY RIGHTS

Act Aug. 23, 1954, ch. 823, 68 Stat. 764, provided that the priority rights specified in section 101 of former Title 35, Patents, which arose before Apr. 1, 1950, were extended, with respect to inventions made subsequent to Jan. 1, 1946, in favor of certain Japanese and German nationals, to a date nine months after Aug. 23, 1954, subject to conditions and limitations specified in sections 104, 110, 112, and 114 of former title 35.

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 104, 111, 154, 172, 273, 373 of this title.

### § 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(July 19, 1952, ch. 950, 66 Stat. 800; Pub. L. 94-131, § 9, Nov. 14, 1975, 89 Stat. 691; Pub. L. 98-622, title I, § 104(b), Nov. 8, 1984, 98 Stat. 3385; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4503(b)(1)], Nov. 29, 1999, 113 Stat. 1536, 1501A-563.)

#### HISTORICAL AND REVISION NOTES

This section represents present law not expressed in the statute, except for the added requirement that the first application must be specifically mentioned in the second.

#### AMENDMENTS

1999—Pub. L. 106-113 inserted at end “No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.”

1984—Pub. L. 98-622 substituted “which is filed by an inventor or inventors named in the previously filed application” for “by the same inventor”.

1975—Pub. L. 94-131 inserted “, or as provided by section 363 of this title,” after “filed in the United States”.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective on date that is 1 year after Nov. 29, 1999, and applicable to all applications filed under section 111 of this title on or after that date, and all applications complying with section 371 of this title that resulted from international applications filed on or after that date, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106-113, set out as a note under section 10 of this title.

#### EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-622 applicable to all United States patents granted before, on, or after Nov. 8, 1984, and to all applications for United States patents pending on or filed after that date, except as otherwise provided, see section 106 of Pub. L. 98-622, set out as a note under section 103 of this title.

#### EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94-131 effective Jan. 24, 1978, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94-131, set out as an Effective Date note under section 351 of this title.

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 111, 121, 154, 273, 365, 373 of this title.

### § 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

(July 19, 1952, ch. 950, 66 Stat. 800; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582.)

#### HISTORICAL AND REVISION NOTES

This section enacts as law existing practice with respect to division, at the same time introducing a number of changes. Division is made discretionary with the Commissioner. The requirements of section 120 are made applicable and neither of the resulting patents can be held invalid over the other merely because of their being divided in several patents. In some cases a divisional application may be filed by the assignee.

#### AMENDMENTS

1999—Pub. L. 106-113 substituted “Director” for “Commissioner” wherever appearing.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

#### EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of Title 15, Commerce and Trade.

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 111, 154, 372 of this title.

### § 122. Confidential status of applications; publication of patent applications

(a) CONFIDENTIALITY.—Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

#### (b) PUBLICATION.—

(1) IN GENERAL.—(A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

(2) EXCEPTIONS.—(A) An application shall not be published if that application is—

(i) no longer pending;

(ii) subject to a secrecy order under section 181 of this title;

(iii) a provisional application filed under section 111(b) of this title; or

(iv) an application for a design patent filed under chapter 16 of this title.

(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in



a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

(c) **PROTEST AND PRE-ISSUANCE OPPOSITION.**—The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

(d) **NATIONAL SECURITY.**—No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title.

(July 19, 1952, ch. 950, 66 Stat. 801; Pub. L. 93-596, § 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4502(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-561.)

#### HISTORICAL AND REVISION NOTES

This section enacts the Patent Office rule of secrecy of applications.

#### AMENDMENTS

1999—Pub. L. 106-113 amended section catchline and text generally. Prior to amendment, text read as follows: “Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.”

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective on date that is 1 year after Nov. 29, 1999, and applicable to all applications filed under section 111 of this title on or after that date, and all applications complying with section 371 of this title that resulted from international applications filed on or after that date, see section 1000(a)(9) [title IV, § 4508] of Pub. L. 106-113, set out as a note under section 10 of this title.

#### EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of Title 15, Commerce and Trade.

#### STUDY OF APPLICANTS FILING ONLY IN UNITED STATES

Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4502(b)], Nov. 29, 1999, 113 Stat. 1536, 1501A-562, provided that:

“(1) **IN GENERAL.**—The Comptroller General shall conduct a 3-year study of the applicants who file only in the United States on or after the effective date of this subtitle [see section 1000(a)(9) [title IV, § 4508] of Pub. L. 106-113, set out as an Effective Date of 1999 Amendment note under section 10 of this title] and shall provide the results of such study to the Judiciary Committees of the House of Representatives and the Senate.

“(2) **CONTENTS.**—The study conducted under paragraph (1) shall—

“(A) consider the number of such applicants in relation to the number of applicants who file in the United States and outside of the United States;

“(B) examine how many domestic-only filers request at the time of filing not to be published;

“(C) examine how many such filers rescind that request or later choose to file abroad;

“(D) examine the status of the entity seeking an application and any correlation that may exist between such status and the publication of patent applications; and

“(E) examine the abandonment/issuance ratios and length of application pendency before patent issuance or abandonment for published versus unpublished applications.”

#### SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 2, 5, 102, 135, 154, 374 of this title.

### CHAPTER 12—EXAMINATION OF APPLICATION

Sec.	
131.	Examination of application.
132.	Notice of rejection; reexamination.
133.	Time for prosecuting application.
134.	Appeal to the Board of Patent Appeals and Interferences.
135.	Interferences.

#### AMENDMENTS

1984—Pub. L. 98-622, title II, § 204(b)(2), Nov. 8, 1984, 98 Stat. 3388, substituted “Patent Appeals and Interferences” for “Appeals” in item 134.